

REMARKS

Claims 1-33 are pending. Applicants amend claims 15 and 22. Applicants request reconsideration and withdrawal of the rejections in view of the following remarks.

Applicants thank the Examiner for the courtesy of an interview with the undersigned attorney on June 20, 2007 to discuss the introduction of new claims 22-33 in response to a previous Examiner's suggestion of allowable subject matter. It was agreed that claims 22-33 would be examined.

The Examiner rejected claims 15-21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,331,166 ("Burbank") or under 35 U.S.C. § 103(a) as being unpatentable over Burbank in view of U.S. Patent No. 5,649,547 ("Ritchart"). Claims 15-21 cover methods that include causing rotation of a stylet along an axis of the stylet by contact between a part of a stylet block and a housing of a medical instrument. Burbank describes a cutting element 20 that is characterized by the Examiner as a stylet block.¹ But, cutting element 20 is attached to a rod 32 which extends out of housing 28 rather than contacting housing 28.² Rotation of shaft 18 (characterized by the Examiner as a stylet) causes rotation of cutting element 20 rather than engagement of cutting element 20 with another element causing rotation of shaft 18.³ Therefore, engagement between cutting element 20 and housing 28 does not cause rotation of a stylet.

The Examiner asserts that "rotation of the stylet 18 is fully due to its engagement to the housing and/or the rest of the device between the second part of the stylet block 20 and the housing or rest of the device."⁴ However, without addressing whether this assertion is correct, Applicants submit that this is not the feature recited in claim 15.

Ritchart does not remedy the deficiencies of Burbank. Thus, neither Burbank nor Ritchart, alone or in combination, discloses or suggests the methods covered by claims 15-21. Further, there is no suggestion to combine these references to provide such methods, and, even if the references were combined, the result would not be the methods covered by claims 15-21.

¹ Office Action mailed June 1, 2007, p. 4.

² See Burbank, col. 5, lines 35-62.

³ See id., col. 5, lines 35-42.

⁴ Office Action mailed June 1, 2007, pp. 10-11.

Accordingly, Applicants request reconsideration and withdrawal of the rejections of claims 15-21.

The Examiner rejected claims 1-14 and 22-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,368,045 ("Clement") in view of U.S. Patent No. 5,197,484 ("Kornberg"), Clement in view of Kornberg and further in view of U.S. Patent No. 5,921,943 ("Kass"), or Clement in view of Kornberg and further in view of U.S. Patent No. 5,394,887 ("Haaga").

Claims 1-14 cover medical instruments including a stylet configured such that axial movement of the stylet from a retracted position to an extended position causes rotation of the stylet. Claims 22-33 cover medical instruments including a stylet configured to rotate when moved from a first retracted position to a first extended position. The Examiner conceded that Clement does not disclose a medical device with a stylet configured to rotate when moved from a retracted position to an extended position.⁵

Kornberg does not remedy the deficiencies of Clement. Kornberg discloses a device with a stylet 58 coaxially received by a cannula 54.⁶ Cannula 54 rotates when the device is actuated,⁷ but stylet 58 is fixed in place by pin member 101.⁸ Rotation of driving member 91 causes forward motion of driving pin 94 and attached cannula.⁹

Applicants do not concede that it would be appropriate to modify Clement's device according to Kornberg's disclosure. Even if such a modification were to be made to Clement's device, the resulting device would not have a stylet, coaxially received within a cannula, configured such that axial movement of the stylet causes rotation of the stylet. Rather the resulting device would be configured such that rotation of the stylet would cause axially motion of the stylet. Nor would one skilled in the art have been motivated to further modify a device resulting from the combination of Clement and Kornberg to provide such a stylet, at least, because Kornberg's device is specifically configured to prevent such rotation.

⁵ See Office Action mailed September 4, 2007, p. 5.

⁶ See Kornberg, FIGS. 11-13 and col. 8, line 63 – col. 10, line 59.

⁷ See id., col. 14, line 45 – col. 15, line 15.

⁸ See id., col. 9, lines 44-52.

⁹ See id., col. 14, lines 26-34.

Independent claim 22 further recites the feature of a stylet block including a first part inside the housing, the first part being moveable between a third extended position and a third retracted position; and a second part attached to the proximal end of the stylet, the second part being rotatably engaged with the first part and being able to rotate relative to an axis of the stylet.

Clement discloses a medical device with a stylet block but does not disclose or suggest the recited features. Kornberg does not remedy this deficiency. Rather Kornberg describes causing rotation of a cannula 54 by rotation of driving member 91.¹⁰ Rotation of driving member 91 causes forward motion of driving pin 94 and attached cannula.¹¹ Driving member 91 rotates (rather than moves between an extended position and a retracted position) and is not attached to the proximal end of the cannula.¹² Driving pin 94 is “fixedly secured to larger diameter section 55 of cannula 54.”¹³

Neither Kass nor Haaga cure the deficiencies of Clement and Kornberg.

None of Clement, Kornberg, Kass and Haaga, alone or in combination, discloses or suggests the medical instruments covered by claims 1-14 and 22-33. There is no suggestion to combine these references to provide the medical devices covered by these claims, and, even if the references were combined, the result would not be the medical devices covered by claims 1-14 and 22-33. Accordingly, Applicants request reconsideration and withdrawal of the rejection of claims 1-14 and 22-33.

For at least the foregoing reasons, Applicants respectfully submit that the application is in condition for allowance.

¹⁰ See Kornberg, col. 9, line 35 – col. 10, line 59 and col. 14, lines 26-34.

¹¹ See id., col. 14, lines 26-34.

¹² See id., FIG. 12, col.9. line 35 – col. 10, line 13, and col.4, line 19 – col. 15, line 15.

¹³ See id., col. 9, lines 35-36.

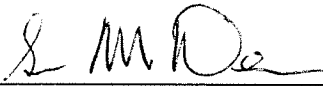
Applicant : Paul DiCarlo et al.
Serial No. : 10/728,248
Filed : December 4, 2003
Page : 10 of 10

Attorney's Docket No.: 01194-824001 / 03-088

No fees are believed to be due. However, please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 01194-824001.

Respectfully submitted,

Date: December 3, 2007



Sean M. Dean, Ph.D., J.D.
Reg. No. 46,656

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906